

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-35 have been canceled. New claims 36-80 are added without adding any new matter.

Claims 22, 24, 33, and 35 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite. These claims have been canceled, and the new claims do not have the language cited by the Examiner, and thus the rejection is moot.

Claims 1 and 3-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Staton (U.S. 4,722,432) in view of Abler (U.S. 5,174,431). Claims 25 and 27-35 are rejected as above as being unpatentable over the references. Claims 2 and 26 were rejected as above, in further view of Doornekamp (U.S. 5,749,453). For the following reasons, the rejections are respectfully traversed.

Claims 1-35 have been canceled, making the rejections moot.

Furthermore, new claim 36 recites a vacuum feeder system comprising a transfer device including:

a cylinder body that can be rotated, wherein said cylinder body is provided
with a plurality of holes through an outer surface of said cylinder
body; and

a plurality of vacuum connection means provided inside said cylinder body
for connecting said vacuum interface to said holes....

The Examiner admits that Staton does not teach a cylinder body, relying on Abler for such a teaching. However, Abler does not teach any *plurality* of vacuum connection means as recited in the claim, and furthermore Abler does not teach that any such plurality of

connection means are provided *inside* the cylinder body. Accordingly, claim 36 is patentable over the references, as are the claims that depend on claim 36.

New claim 55 recites vacuum feeder system comprising:

a rotating cylinder body having a plurality of first holes on a surface of the cylindrical body, said cylinder body also have a plurality of second holes on an end of said cylinder body, and

a plurality of connections, wherein each one of said first holes is connected to a corresponding one of said second holes via one of said plurality of connections

Claim 68 recites:

a rotating cylinder body having a plurality of first holes on a surface of the cylindrical body, said cylinder body also have a plurality of second holes connected to a vacuum interface, and

a plurality of connections, wherein each one of said first holes is connected to a corresponding one of said second holes via one of said plurality of connections...

Staton and Abler fail to teach any cylinder body having first holes and second holes arranged as recited and connected with a plurality of connections as recited, and thus claims 55 and 68, and the claims dependent thereon, is also patentable over the references.

Doornekamp fails to overcome the above discussed shortcomings, and thus the claims are patentable over any combination of the references.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01), or some other recognized reason to make the proposed modification.

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any

references or arguments based on the skill of the art supporting the recommended modifications. Merely listing an advantage or benefit of the combination, or arguing that such choices are merely “design choices” is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Applicant notes that the “design choices” suggested by the Examiner are only a subset of an infinite number of combinations of design choices, and thus the Examiner must provide some rationale as to why the particular choices provided in the claims would be selected by one skilled in the art. No such rationale has been provide, and thus the Examiner has failed to provide a prima facie case for obviousness and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. SCAN1-40146.

Respectfully submitted,
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